


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q64648	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	09/863,476	May 24, 2001	
	First Named Inventor Yasuhiro SHINKAI		
	Art Unit	Examiner	
	3629	Tan D. NGUYEN	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 41,239</p> <div style="text-align: right;">  Signature </div> <div style="text-align: right;"> Susan P. Pan Typed or printed name </div> <div style="text-align: right;"> (202) 293-7060 Telephone number </div> <div style="text-align: right;"> April 17, 2007 Date </div>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64648

Yasuhiro SHINKAI

Appln. No.: 09/863,476

Group Art Unit: 3629

Confirmation No.: 1262

Examiner: Tan D. NGUYEN

Filed: May 24, 2001

For: PRINT ORDER ACCEPTANCE SYSTEM AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Program, and further to the Examiner's Final Office Action dated November 17, 2006, Applicant submits the following legal and technical bases on why the pending rejections should be withdrawn.

Claims 1-5, 10, and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 6,771,896).

Claims 1-5, 6-9, 10, 12, 15 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 6,771,896), Dawe (Article) and Chui et al. (U.S. Patent No. 6,657,702).

Applicant's invention relates to methods and apparatus for providing confirmation of image data, such as via thumbnail of images, which are printed by a voucher printer separate from an image printer. In particular, a voucher printer prints a voucher including thumbnail images and details on order information for the image data. As an alternative method of confirmation, the technique of the present invention includes sending electronic mail, after an

order has been placed, which includes thumbnail information and order information. This electronic mail is delivered to the person who placed the order.

The Examiner contends that Tamura teaches each feature of independent claim 1. Tamura teaches at least two distinct embodiments. The embodiment of Fig. 3 relates to the receipt of order information for printing by a photofinisher. The embodiment of Figs. 9 and 12 relate to printing in a home environment. The Examiner cannot rely on a combination of distinct embodiments without a basis for the combination. Two embodiments in a single reference may not be combined absent specific teaching. In re Kramer, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991); Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003). In the rejection of independent claims 10 and 1, the Examiner relies on the combined teachings of the photofinisher embodiment of Fig. 3 and the home printing system of Figs. 9 and 12. See page 4 of detailed action, top half of page. This is improper.

Relatedly, the Examiner's proffered motivation to provide a separate printer (130) for the thumbnail and the image data is to provide more efficient operation when cost is not a consideration. However, the printer system including 130 is provided in a home environment (Fig. 9). In such a home-use environment, the costs to a consumer are paramount and would outweigh any marginal efficiencies gained because orders are processed for an individual household and not a large volume of users. The Examiner's citation to the printers 220 and 212 of Fig. 4 also do not support the rejection. This is because printer 212 prints a coupon but does not print a thumbnail. The printer 212 prints data such as order contents, charges, order number, user name, and finishing time for the order. To the extent that the Examiner contends that it would be obvious to print a thumbnail for purposes of order confirmation, it is noted that the coupon information can be correlated with the image data of a co-located camera (Fig. 4, element 100). Because the camera itself can generate a thumbnail, the confirmation can be

efficiently made through the camera without generation of the thumbnail print. Applicant submits that the Examiner's motivation for modifying Tamura is not supportable, and claims 10 and 1 are patentable. Claims 2-5 and 16-18 are patentable based on their dependency.

Even assuming *arguendo* that it is proper for the Examiner to combine the different embodiments of Tamura, their combination does not teach each feature of claim 1.

Claim 1 describes a voucher printer which is 1) separate from an image printer, to print a voucher including the 2) details of a print order and 3) thumbnail images of the order. No printer or combination of printers in Tamura teaches all these aspects of the voucher printer. In particular, the printer 212 of a first embodiment of Tamura does not print a thumbnail, and the printer 130 of the second embodiment of Tamura is the same printer that prints the image data. The Federal Circuit has indicated that when a claim element includes multiple features, the prior art must also teach the element with the multiple features. Kimberly Clarke Corp. v. J & J Personal Products, 223 USPQ 603, 609-610 (Fed. Cir. 1984). In the Kimberly Clark case, the Federal Circuit recognized that a certain adhesive had two functions of 1) acting as a sealant and 2) acting as an attachment device. The court emphasized the dual characteristics as a key to validity (e.g. patentability). The Kimberly Clarke case continues a line of CCPA decisions where patentability was found due to a duality of characteristics for a particular element. In In re Krammes, 137 USPQ 60, 62-63 (CCPA 1963), a claimed receptacle space had a function of housing both a cleaning fluid and acting as a reservoir for waste water. The CCPA overturned the Board's rejection since the prior art did not have a receptacle space that had such dual functionality. In Motorola v. Interdigital Tech., 43 USPQ2d 1481, 1490 (Fed. Cir. 1997), the Federal Circuit also applied the multiple functions of a code to determine that the claims were valid over a prior art reference that lacked a code with such multiple functions. The current situation is analogous to each of Kimberly Clarke, Krammes and Motorola where a particular

printer has multiple functionality that must be considered for patentability purposes. In particular, none of the printers in Tamura will 1) print both a) voucher with order information detail and b) a thumbnail and also 2) be separate from the image printer. Therefore, claim 1 is patentable for at least this reason.

The Examiner's rejection also suggests that it would be obvious to one skilled in the art to include multiple printers to teach a thumbnail printer separate from an image printer. However, the Examiner's rationale, at best, teaches that three printers are used to print three different outputs 1) the image data; 2) the voucher and 3) the printer. Such a basis for invalidity (unpatentability) based on duplication of elements was flatly rejected in the Kimberly Clark case. The inclusion of additional printers still does not lead to a printer with the dual characteristics of printing a voucher with a) order details and b) thumbnail images. Therefore, claim 1 is patentable for this additional reason.

The Examiner contends that the use of a thumbnail as a hard copy confirmation is sufficient to support the rejection. This contention is incorrect because it ignores the multiple characteristics of the voucher printer. The thumbnail confirmation can provide its confirmation function whether it is printed by the same printer as the image data or by an additional third printer. There is no requirement that the confirmation thumbnail must be printed by the same voucher printer that prints the details of the order. Therefore, claim 1 is patentable for this additional reason. Because claim 10 includes recitations analogous to that set forth above for claim 1, claim 10 is patentable for the reasons set forth above. Claims 2-5 and 16-18 are patentable based on their dependency. The Examiner also rejects claim 1 over the combination of Tamura, Dawe and Chui. However, Dawe and Chui do not make up for the above deficiencies of Tamura. In particular, because Dawe relates to confirmation of computer orders, Dawe fails to teach any aspect of thumbnail image printing. Chui teaches no embodiment where

a single printer, separate from an image printer, prints both a voucher including order details and a thumbnail.

Even assuming *arguendo* that Tamura, Dawe and Chui are properly combined, their combination still fails to teach the voucher printer with the multiple characteristics as claimed. Therefore, claims 1 and 10 and their dependent claims are patentable over the combination of Tamura, Dawe and Chui.

With regard to the rejection of claim 6 over the combination of Tamura, Dawe and Chui, Applicant submits that the rejection is improper. The Examiner also concedes that Tamura does not teach the transmission of thumbnail data and cites Dawe and Chui to make up the deficiency. With regard to Dawe, this reference does not transmit any thumbnail images. Therefore, Dawe clearly does not make up the deficiencies of Tamura. With regard to Chui, the Examiner cites col. 1, lines 45-67, col. 17, lines 25-40, col. 21, lines 40-50 and Fig. 9. No aspect of Chui supports the rejection. Col. 1 merely refers to transmission of the image data itself, not thumbnail information. Cols. 17, 21 and Fig. 21 all relate to sending of emails to third party recipients. None of the cited portions describe email of thumbnail information to the person who placed the order as describe by claim 6. This argument was previously submitted, and the Examiner has yet to rebut this basis for withdrawal of the rejection. Thus, the cited combination fails to teach all aspects of claim 6. Claim 11 is patentable based on analogous recitations.

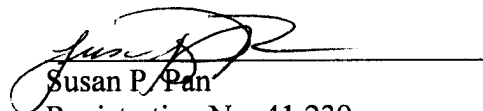
Respectfully submitted,

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